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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/044,353

01/10/2002

John L. Dennis

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11/18/2003

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MINNEAPOLIS, MN 55402-1498

EXAMINER

PASCUA, JES F

ART UNIT

PAPER NUMBER

3727

DATE MAILED: 11/18/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

10/044,353

Applicant(s)

DENNIS, JOHN L.

Examiner

Jes F. Pascua

Art Unit

3727

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 27 September 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 11-27 is/are pending in the application.
- 4a) Of the above claim(s) 11-17 and 23-27 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 18-22 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 10 January 2002 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.  
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Election/Restrictions***

1. Newly submitted claims 23-27 are directed to an invention that is independent or distinct from the invention originally claimed for the following reasons: the product as claimed can be made by another and materially different process such as forming the panel into a pouch prior to forming the frangible piercing point. Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claims 23-27 have been withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

### ***Drawings***

2. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the first and second substantially straight line segment joined to each other by the arcuate line segment (claim 21) must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

### ***Specification***

3. The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o). Correction

of the following is required: first and second straight line segments and arcuate line segment lack antecedence in the specification.

***Claim Rejections - 35 USC § 112***

4. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

5. Claims 18-22 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The specification, as originally filed, fails to provide antecedent basis for the language "but no more than one continuous channel through the polymer layer" and "but no more than one substantially enclosed area". This is a new matter rejection.

6. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

7. Claims 18-22 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 18, the language "at least one, but no more than one continuous channel through the polymer layer" is confusing. The phrase "at least one" implies that there may be more than one continuous channel. However, the phrase "but no more than one" requires that there is **only one** continuous channel. The two phrases contradict each other, thus rendering the scope of the claim indeterminable.

In claim 18, the language "at least one, but no more than one substantially enclosed area" is confusing. The phrase "at least one" implies that there may be more than one substantially enclosed area. However, the phrase "but no more than one" requires that there is **only one** substantially enclosed area. The two phrases contradict each other, thus rendering the scope of the claim indeterminable.

Claims 19-22 are rejected since they depend from claim that has been rejected under 35 U.S.C. 112, second paragraph.

### ***Claim Rejections - 35 USC § 102***

8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

9. Claim 18 is rejected under 35 U.S.C. 102(b) as being clearly anticipated by  
Arkins et al.

***Claim Rejections - 35 USC § 103***

10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

11. Claim 19 is rejected under 35 U.S.C. 103(a) as being unpatentable over Arkins et al.

Arkins et al. discloses the claimed invention except for the arc-shaped channel of Arkins et al. forming a cord of at least 180 degrees . It would have been an obvious matter of design choice to form the arc-shaped channel of Arkins et al. such that it forms a cord of at least 180 degrees , since such a modification would have involved a mere change in the size of a component. A change in size is generally recognized as being within the level of ordinary skill in the art. *In re Rose*, 105 USPQ 237 (CCPA 1955).

12. Claim 20 is rejected under 35 U.S.C. 103(a) as being unpatentable over Arkins et al.

Arkins et al. discloses the claimed invention except for the arc-shaped channel defining a teardrop-shaped substantially enclosed area. It would have been an obvious matter of design choice to configure the arc-shaped channel of Arkins et al. such that it defines a teardrop-shaped substantially enclosed area or whatever form or shape was desired or expedient. A change in form or shape is generally recognized as being within

the level of ordinary skill in the art, absent any showing of unexpected results. *In re Dailey et al.*, 149 USPQ 47.

13. Claims 21-22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Arkins et al. in view of Robichaud et al.

Arkins et al. discloses the claimed invention except that Arkins et al. shows an arcuate-shaped channel instead of a channel comprising first and second, parallel straight line segments connected at their ends by an arcuate line segment. Robichaud et al. shows that a channel defined by first and second, parallel straight line segments connected at their ends by an arcuate line segment is an equivalent structure known in the art. Therefore, because these two frangible piercing points were art-recognized equivalents at the time the invention was made, one of ordinary skill in the art would have found it obvious to substitute the arcuate-shaped channel of Arkins et al. for a channel comprising first and second, parallel straight line segments connected at their ends by an arcuate line segment.

14. Claims 18-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Yoshida in view of Kramer et al.

Yoshida discloses the claimed invention except that Yoshida shows the frangible piercing point defined by a Y-shaped channel instead of an arcuate-shaped channel. Kramer et al. shows that an arcuate-shaped channel (e.g. "simi-circular") is an equivalent structure known in the art. Therefore, because these two frangible piercing points were art-recognized equivalents at the time the invention was made, one of

ordinary skill in the art would have found it obvious to substitute the Y-shaped channel in Yoshida for an arcuate-shaped channel.

As a note, the "simi-circular" channel of Kramer et al. inherently defines a substantially enclosed area and hinge as claimed.

Regarding claim 19, it would have been an obvious matter of design choice to form the arc-shaped channel of Kramer et al. such that it forms a cord of at least 180 degrees, since such a modification would have involved a mere change in the size of a component. A change in size is generally recognized as being within the level of ordinary skill in the art. *In re Rose*, 105 USPQ 237 (CCPA 1955).

Regarding claim 20, it would have been an obvious matter of design choice to configure the arc-shaped channel of Kramer et al. such that it defines a teardrop-shaped substantially enclosed area or whatever form or shape was desired or expedient. A change in form or shape is generally recognized as being within the level of ordinary skill in the art, absent any showing of unexpected results. *In re Dailey et al.*, 149 USPQ 47.

15. Claims 21-22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Yoshida in view of Kramer et al., as applied in claim 18, and in further view of Robichaud et al.

Yoshida and Kramer et al. disclose the claimed invention except that Kramer et al. shows an arcuate-shaped channel instead of a channel comprising first and second, parallel straight line segments connected at their ends by an arcuate line segment. Robichaud et al. shows that a channel defined by first and second, parallel straight line



segments connected at their ends by an arcuate line segment is an equivalent structure known in the art. Therefore, because these two frangible piercing points were art-recognized equivalents at the time the invention was made, one of ordinary skill in the art would have found it obvious to substitute the arcuate-shaped channel of Kramer et al. for a channel comprising first and second, parallel straight line segments connected at their ends by an arcuate line segment.

### ***Response to Arguments***

16. Applicant's arguments filed 9/22/03 have been fully considered but they are not persuasive. Applicant agrees that Arkins et al. shows a straw piercing area including a polymer layer being removed by laser. However, applicant argues that Arkins et al. does not show "at least one, but no more than one continuous channel through the polymer layer", "at least one, but no more than one substantially enclosed area" and "a hinge adjacent to the substantially enclosed area and retaining the exterior polymer layer". Claim 1 of Arkins et al. requires "one or more areas of delamination" which inherently results in one or more areas of Arkins et al. exterior polymer film being removed by laser, thus meeting applicant's limitations "at least one, but no more than one continuous channel through the polymer layer" and "at least one, but no more than one substantially enclosed area". Claim 5 of Arkins et al. require that the area of delamination is "arc-shaped". According to the Arkins et al. disclosure, this implies that the area of the exterior polymer layer removed by laser would also be arc-shaped. Therefore, the arc-shape claimed by Arkins et al. inherently meets the limitations "at

least one, but no more than one substantially enclosed area" and "a hinge adjacent to the substantially enclosed area and retaining the exterior polymer layer".

17. Applicant's arguments with respect to Kramer et al. and Yoshida have been considered but are moot in view of the new ground(s) of rejection.

### ***Conclusion***

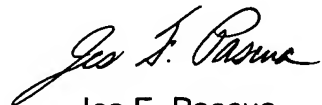
18. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jes F. Pascua whose telephone number is 703-308-1153. The examiner can normally be reached on Mon.-Thurs..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Lee W. Young can be reached on 703-308-2572. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9302.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1078.



Jes F. Pascua  
Primary Examiner  
Art Unit 3727

JFP